

## REMARKS

Claims 1-55 were pending prior to this amendment. In the non-final Office action mailed June 3, 2003, the Examiner has rejected claims 1-30, 36-40, and 47-50, and has objected to claims 31-55, 41-46, and 51-55. In that Office action, the Examiner had withdrawn an earlier Restriction Requirement. Reconsideration of the pending claims, as amended herein, is respectfully requested.

Claims 31-35, 41-46, and 51-55 are now pending.

### **Claim Amendment**

Applicants have canceled claims 1-30, 36-40, and 47-50. Applicants reserve the right to pursue the subject matter claims 1-30, 36-40, and 47-50 in a continuation application. Claims 31, 41, and 51 have been rewritten into independent form, including all of the limitations of the base claim and any intervening claims. Accordingly, no new matter under 35 U.S.C. §132 has been added by way of this amendment. Accordingly, claims 31-35, 41-46, and 51-55 are now pending.

### **Claim rejections under 35 U.S.C. §112, second paragraph**

The Examiner has rejected claims 4-15 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention. In particular, the Examiner states that regarding the phrase "target polynucleotide" on step (a), "it is not clear if the target polynucleotide is a part of the polynucleotide sample being detected or it is bigger than the polynucleotide sample or it is part of another reference polynucleotide or all of them." "The Examiner also states "in the absence of a clear definition of "target polynucleotide" either in the specification or in the claim, the metes and bounds of the claims are vague and indefinite. Applicants respectfully traverse this rejection and politely disagree with the Examiner's statement that there is an "absence of a clear definition of "target polynucleotide either in the specification or in the claim. . . ."

The term "target polynucleotide" is a term commonly used in molecular biology to refer to a polynucleotide which has a nucleotide sequence of interest. Indeed, the term

"target" is defined by Merriam-Webster's Dictionary as meaning "something that is or may be aimed at". Moreover, the ordinary use in the art, as well as the specification, provide context to the term "target polynucleotide" such that the term, if used in a patent claim, would not cause one of ordinary skill in the art to be unclear as to what are the "metes and bounds" of the claim. Applicants, however, in the interest of compact prosecution, have cancelled claims 4-15. Accordingly, the Examiner's rejection under 35 U.S.C. §112, second paragraph is now moot. Applicants respectfully request withdrawal of the rejection.

### **Claim rejections under 35 U.S.C. §102**

#### *Caetano-Anolles*

The Examiner has rejected claims 1-11, and 13 under 35 U.S.C. §102(b) as being anticipated by Caetano-Anolles, et al., PCT Publication No. WO 95/33853, published December 14, 1995. Applicants respectfully traverse this rejection for the following reason.

In the interest of compact prosecution, Applicants have cancelled claims 1-11, and 13 without prejudice towards pursing such subject matter in a continuation application. Accordingly, the Examiner's rejection under 35 U.S.C. §102(b) is now moot. Applicants respectfully request withdrawal of this rejection.

#### *Tatari*

The Examiner has rejected claims 1-8, 10-11, 13, 15-17, 20, 36-37, 40, and 47-48 under 35 U.S.C. §102(b) as being anticipated by Tatari et al, Proc. Natl. Acad. Sci. USA (1995), Vol 92, pp 8803-8807. Applicants respectfully traverse this rejection for the following reason.

In the interest of compact prosecution, Applicants have cancelled claims 1-8, 10-11, 13, 15-17, 20, 36-37, 40, and 47-48 without prejudice towards pursing such subject matter in a continuation application. Accordingly, the Examiner's rejection under 35 U.S.C. §102(b) is now moot. Applicants respectfully request withdrawal of this rejection.

## **Claim rejections under 35 U.S.C. §103**

### *The Tatari-Goodwin combination*

The Examiner has rejected claims 9, 12, 18, 19, 21-28, 30, 38, 39, and 50 under 35 U.S.C. §103(a) as being obvious over Tatari, in view of Goodwin et al., Nucleic Acids Research (1993) Vol 21(4), pp 803-806. Applicants respectfully traverse this rejection for the following reason.

In the interest of compact prosecution, Applicants have cancelled claims 9, 12, 18, 19, 21-28, 30, 38, 39, and 50 without prejudice towards pursing such subject matter in a continuation application. Accordingly, the Examiner's rejection under 35 U.S.C. §103(a) is now moot. Applicants respectfully request withdrawal of this rejection.

### *The Tatari-Kanter combination*

The Examiner has rejected claim 14 under 35 U.S.C. §103(a) as being obvious over Tatari, in view of Kanter et al., J. of Forensic Sciences (1986) Vol 31(2) 403-408. Applicants respectfully traverse this rejection for the following reason.

In the interest of compact prosecution, Applicants have cancelled claim 14 without prejudice towards pursing such subject matter in a continuation application. Accordingly, the Examiner's rejection under 35 U.S.C. §103(a) is now moot. Applicants respectfully request withdrawal of this rejection.

### *The Tatari-Langmore combination*

The Examiner has rejected claims 29 and 49 under 35 U.S.C. §103(a) as being obvious over Tatari, in view of Langmore et al., US Patent No. 6,117,634 (September 12, 2000). Applicants respectfully traverse this rejection for the following reason.

In the interest of compact prosecution, Applicants have cancelled claims 29 and 49 without prejudice towards pursing such subject matter in a continuation application. Accordingly, the Examiner's rejection under 35 U.S.C. §103(a) is now moot. Applicants respectfully request withdrawal of this rejection.

## CONCLUSION

Applicants believe the claims are now in condition for allowance for the foregoing reasons. Accordingly, Applicants respectfully request consideration of the claims on their merits. If, in the Examiner's opinion, a telephone conference may be helpful, Applicants' counsel may be contacted at the number below.

Presented with the highest regards  
under 37 C.F.R. §1.34(a),



Gregory L. Heinkel  
Reg. No. 44,755

Fluidigm Corporation  
7100 Shoreline Court  
So. San Francisco, CA, 94080  
(650) 266-6036  
(650) 871-9308

Please address all correspondence to:

Townsend and Townsend and Crew  
Two Embarcadero Center  
Eighth Floor  
San Francisco, CA, 94111-3834